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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,577	06/23/2003	Kinya Aota	503.35255VX2	9631

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EXAMINER

STONER, KILEY SHAWN

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/600,577	AOTA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kiley Stoner	1725	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/820,231.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6-23-03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group I (claims 1-22) in the reply filed on 2-22-05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). This restriction is now moot because the applicant has canceled the non-elected claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant is claiming:

#### **Claim 1**

"providing respectively a recessed portion, in a thickness direction, to an outer face at one side of said first member and to an outer face at another side of said first member, opposite said one side and providing a third member extending from said recessed portion at said one side to said recessed portion at said other side, ..., carrying out a friction stir welding at said overlapped portion by inserting a rotary tool at said

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overlapped portion from an outer side of the first member, said rotary tool being inserted so as to overlies a central portion of a width of the third member".

## Claim 8

"preparing a first member having a first plate, a second plate substantially in parallel to said first plate, and a third plate connecting an end portion of said first plate and said second plate and being substantially orthogonal to said first plate, providing a recessed portion of a connection portion between said third plate and said first plate, opening said recessed portion directed toward an outer side in a thickness direction of said first member and toward one end side of said first member, overlapping an end portion of a second member to said recessed portion, to provide an overlapped portion, and under a condition where a connection portion of said second plate and said third plate is supported, carrying out a friction stir welding at said overlapped portion using a rotary tool located at an outer side of an end side of said second member, wherein while carrying out the friction stir welding the rotary tool overlies a central portion of a width of the third member".

## Claim 13

"preparing a first member having a first plate, a second plate substantially in parallel to said first plate, and a third plate for connecting an end portion of said first plate and said second plate and being substantially orthogonal to said first plate, providing respectively a recessed portion to a connection portion of said third plate and said first plate and a recessed portion to a connection portion of said third plate and said second plate, the respective recessed portions having openings directed toward an outer side in a thickness direction of said first member and a side of said one end of said first member, overlapping an end portion of a second member to said respective recessed portions, forming overlapped portions, and under a condition where said first member and said second member at one of the overlapped portions is supported, positioning a rotary tool in an extension line in a plate thickness of said third plate and inserting said rotary tool to the other of the overlapped portions from said outer side, and carrying out a friction stir welding to said overlapped portion".

## Claim 17

"preparing a first member and a second member each having a first plate, a second plate substantially parallel to said first plate, and a third plate for connecting a midway of an end portion of said second plate and said first plate, providing respectively a recessed portion to a connection portion of said third plate and said first plate of said first member and a recessed portion to a connection portion of said third plate and said

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second plate of said first member, opening the respective recessed portions directed toward an outer side in a thickness direction of said respective member and a side of said end portion of said respective member, overlapping an end portion of said first plate of said second member to one of the recessed portions of said first member, to provide an overlapped portion, and under a condition where said first plate of said first member and said first plate of said second member are supported, carrying out friction stir welding of said overlapped portion by inserting a rotary tool to said overlapped portion between said recessed portion of said first member and said second plate of said second member from at least an outer side of said first plate of said second member, wherein said rotary tool is inserted so as to overlie a central portion of a width of said third plate of said first member at said overlapped portion".

In the instant application, the only mention of the "third member" is in the abstract, which states "The panels 31, 32 each have two substantially parallel plates 33, 34 and a third member 35 connecting the two plates 33, 34". Thus, the subject matter in the claims is not described in the specification. This subject matter is also not found in the parent application 08/820,231 including the originally filed claims. If the applicant attempts to put these limitations in the instant application, the examiner will have to make a new matter rejection unless the applicant is able to convince the examiner that the claimed subject matter has been previously disclosed.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-11 of U.S. Patent No. 6,840,426. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader than those in 6,840,426. Thus, the claims of the instant application are envisioned by claims 8-11 of U.S. Patent No. 6,840,426. In addition, it is obvious that the friction stir welding is carried out to a depth below said recessed portion in order to ensure an adequate friction stir welding joint.

### ***Conclusion***

The prior art of record that is cited as of interest is presented on the form-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiley Stoner whose telephone number is (571) 272-1183. The examiner can normally be reached on Monday-Thursday (7:30 a.m. to 6:00 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on Monday-Friday at (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KILEY S. STONER  
PRIMARY EXAMINER

*Kiley Stoner* 3/22/05